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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,272	09/23/2005	Yong Chul Shin	Q90361	1263

23373 7590 01/28/2008  
SUGHRUE MION, PLLC  
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SUITE 800  
WASHINGTON, DC 20037

EXAMINER
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MELLER, MICHAEL V

ART UNIT	PAPER NUMBER
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1655

MAIL DATE	DELIVERY MODE
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01/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/550,272

**Applicant(s)**

SHIN ET AL.

**Examiner**

Michael V. Meller

**Art Unit**

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of group II, claims 14, 15 and 16-22 in the reply filed on 11/28/2007 is acknowledged.

Thus, claims 1-13 are withdrawn from further consideration as being drawn to non-elected inventions.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is nothing in the specification to indicate that applicant had possession of any and all methods of treating or preventing any and all liver diseases using pinitol, chiroinositol, or an extract containing one of them.

Liver disease is very hard to treat and impossible to prevent. How can applicant really expect to prevent any and all liver diseases ? It is not possible to prevent each and every liver disease. Unless applicant can show on the record that they treated and prevented each and every liver disease, applicant is not in possession of treating or preventing liver disease. There are many types of liver disease and one treatment for one may not work with another.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Uchida et al.

Uchida teaches that pine extract is heated and extracted with water that has been heated, see col. 2, lines 30-end. The pine extract can be administered in a soft

drink or tablet form, see col. 4, lines 1-10. The extract can also be administered in the range of 0.001-10 g/day/adult, see col. 5, lines 15-25. It can also be administered in tobacco form (clearly intended for humans). Clearly a panel test was also used which clearly is humans since taste and smell were evaluated, see col. 6, experiment 1. The limitation of preventing makes the claims read on anyone since anyone can benefit from having a disease prevented. Further, the limitation of claim 15 is confusing since it is not relative to anything which has been defined. Thus, the amount is without merit.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al.

Uchida teaches that pine extract is heated and extracted with water that has been heated, see col. 2, lines 30-end. The pine extract can be administered in a soft drink or tablet form, see col. 4, lines 1-10. The extract can also be administered in the range of 0.001-10 g/day/adult, see col. 5, lines 15-25. It can also be administered in

tobacco form. Clearly a panel test was also used which clearly is humans since taste and smell were evaluated, see col. 6, experiment 1. The limitation of preventing makes the claims read on anyone since anyone can benefit from having a disease prevented. Further, the limitation of claim 15 is confusing since it is not relative to anything which has been defined. Thus, the amount is without merit.

In the event that it is felt that Uchida does not teach the claimed amount of pine extract it would have been clearly obvious to use such an amount especially in view of the teachings of Uchida which clearly teaches an administration range of 0.001-10 g/day/adult, see col. 5, lines 15-25, which clearly reads on the claim limitation and if not literally it would have been obvious to adjust the amounts of the pine extract in an effort to optimize the desired results.

The result-effective adjustment in conventional working parameters (e.g., determining an appropriate amount of the components within the composition) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

The extract procedure of claim 22 is obvious since as stated by Uchida at col. 2, lines 35-55, conventional extraction methods were used in Uchida including hot water extraction. To heat the water to the claimed temperature for the time indicated and then filter is simply old routine extraction techniques. It would have been well within the

purview of the skilled artisan to use the claimed extraction procedure since hot water extraction is well known and to heat it at such a temperature, time and then filter is simply a matter of routine optimization.

The result-effective adjustment in conventional working parameters (e.g., determining an appropriate amount of the components within the composition) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 571-272-0967. The examiner can normally be reached on Monday thru Thursday: 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'M. Meller', followed by a long horizontal line extending to the right.

Michael V. Meller  
Primary Examiner  
Art Unit 1655